

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

WINTER

Mailed: January 18, 2008

Opposition No. 91179940

MedAvante, Inc.

v.

ProxyMed, Inc.

Jyll S. Taylor, Administrative Trademark Judge:

On November 16, 2007, applicant filed a motion to suspend this proceeding until final determination of a civil action between the parties pending in the United States District Court for the District of New Jersey (Trenton), captioned MEDAVANTE, INC. v. PROXYMED, INC., *et al.* (Case No. 3:06cv3248). Applicant submitted a copy of the complaint in the civil action with its motion. The motion is fully briefed.

Applicant argues that suspension of this proceeding is proper because the referenced civil action is still pending and will have a bearing on the issues before the Board. Specifically, applicant contends that the final determination of the district court proceeding will affect whether applicant may register and/or use the trademark MEDAVANT and variations thereof, including the mark that is the subject of this

Opposition No. 91179940

opposition proceeding.

In opposition, opposer argues that the civil action has been settled and was dismissed on February 16, 2007; that the only remaining matter in the civil case is opposer's pending motion requesting that the district court enforce the parties' settlement agreement; and that the assigned U.S. Magistrate has filed a report and recommendation that the settlement should be enforced.

In reply, applicant argues that the civil action has not been resolved inasmuch as there is an expected ruling to be issued by U.S. District Judge Cooper regarding whether there is a settlement of the litigation or if the civil action will be reopened. Applicant submitted the affidavit, with exhibits, of its counsel, Theodore J. Kobus III, to support its position that the civil matter is not concluded.

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action that may be dispositive of or have a bearing on the Board case. See Trademark Rules 2.127(a) and 2.117(a), 37 C.F.R. §§ 2.127(a) and 2.117(a). See also TBMP § 510.02 (2d ed. rev. 2004).

On review of the parties' arguments and supporting evidence, the Board finds that suspension is proper. In paragraph 39 of the civil complaint, opposer alleges *inter alia* that applicant's adoption and use of its "INFRINGEMENT

Opposition No. 91179940

MARKS" "is likely to cause confusion, cause mistake and/or to deceive those in the relevant market." The referenced civil action involves applicant's use of the marks MEDAVANT, MedAvant (and design) and MedAvant Healthcare Solutions, and its respective intent to use trademark applications for said marks, *i.e.* application Serial Nos. 78761661, 78761691 and 78761704. This proceeding concerns applicant's rights in the mark "NPPN NATIONAL PREFERRED PROVIDER NETWORK A MEDAVANT NETWORK" (and design). The court's decision regarding applicant's right to use the MEDAVANT marks(s) will therefore have a bearing on this proceeding. Notably, the parties do not argue otherwise. Further, and more importantly, there is an on-going dispute as to whether the parties have, in fact, settled the civil action or whether the civil case will be reopened or appealed.

Accordingly, in the interest of judicial economy and consistent with our inherent authority to regulate our own proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion, proceedings are **SUSPENDED** pending final disposition of the civil action between the parties.

Within TWENTY DAYS after the final determination of the civil action, the parties shall so notify the Board and call this case up for any appropriate action. During the

suspension period the Board shall be notified of any address changes for the parties or their attorneys.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>